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ART UNIT

PAPER NUMBER

2642

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

89/192303

Applicant(s)

M. Deguchi

Examiner

J. Chiang

Group Art Unit

2642

#9

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 11-17-98

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-30 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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**CLAIMS**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1, 14, 24, 4, 9, 17, 21-23, 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Macor (US 5901222).

Regarding claim 1, Macor shows:

a display (312 or, 8 and 16);

a transmitter (310 or 20);

a key section (314 or 22);

information items (information on 312, see also information shown in fig. 5); and

the selection and execution of the selected information by the key (col. 4, lines 40-43).

Regarding claim 14, Macor shows:

a main housing (fig. 1 or fig. 2);

a first user interface or a display (312 or, 8 and 16);

a second user interface (310 or 20);

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an input device having a first and second portion (314 or 22) positioned on the housing (fig. 1 or 2);

an item (information on 312, see also information shown in fig. 5); and

the selection and execution of the selected item by the key (col. 4, lines 40-43).

Regarding claim 24, Macor shows:

displaying (312 or, 8 and 16) a menu having items and a highlight bar (see fig. 5, see also col. 4, lines 45-49);

a housing (fig. 1 or 2);

a first user interface or display (312 or 4, 8);

a second user interface or transmitter (310 or 20);

an input device having a first part (314 or 22);

moving the highlight bar to select an item (see 25 in fig. 5); and

the execution of the selected item (col. 4, lines 40-43).

Regarding claims 4, 9, 17, 21-23, Macor shows:

the joystick-type key (col. 2, lines 58-64);

an input controller, a memory, a display controller, a speech processor, a channel controller, a transceiver and a microphone are all conventional features of a cell phone shown by Macor.

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Regarding claims 25-30, Macor shows;

scrolling the highlight bar to retrieve items from a memory (col. 5, lines 41-44);

reading data and arranging the data in the display (see fig. 9);

selecting a communication address, initiating a communication protocol in a portable communication device with another device (see fig. 9).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 -7, 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macor in view of JP 6-90200.

Regarding claim 6, Macor shows:

a display (312 or, 8 and 16);

a transmitter (310 or 20);

a key section (314 or 22);

a plurality of key contacts (moving and executing 25);

information items (information on 312, see also information shown in fig. 5); and

the selection and execution of the selected information by the key (col. 4, lines 40-43).

Macor differs from the claimed invention in that it does not show a second key section.

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However, JP 6-90200 teaches providing a keypad having first (8) and second (13) key sections. Hence, it would have been obvious for one skilled in the art to modify Macor with a second key section as taught by JP 6-90200, such that a user has an option of using the first key section to make a telephone call or to search the memory in the device, or using the second key section to make a direct call.

Regarding claims 10, Macor shows:

a display (312 or, 8 and 16);

a transmitter (310 or 20);

a keypad having a first key section and key contacts (314 or 22);

information items (information on 312, see also information shown in fig. 5); and

the selection and execution of the selected information by the key (col. 4, lines 40-43).

a memory and controller (see fig. 9).

Macor differs from the claimed invention in that it does not show a second key section or ten-key pad.

However, JP 6-90200 teaches providing a keypad having first (8) and second (13) key sections. Hence, it would have been obvious for one skilled in the art to modify Macor with a second key section as taught by JP 6-90200, such that a user has an option of using the first key section to make a telephone call or to search the memory in the device, or using the second key section to make a direct call.

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Regarding claims 7, 11, 13, Macor shows the movement key contacts and execution key contact (with 314 or 22); and the joystick-type of key (col. 2, lines 58-64).

3. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macor in view of Brandenburg et al. (US 5231386).

Regarding claims 18-20, Macor has the execution contacts and the up, down, left and right contacts in order to move the cursor and execute the selected item.

Macor differs from the claimed invention in that it does not explicitly show the internal structure of the key, such as the conductive dome and its contacts.

However, keys which have conductive dome are well known in the art. This is taught by Brandenburg, such as the dome and contacts (21 32 ). Hence, if it is found that Macor does not use the conductive dome, then it would have been obvious for one skilled in the art to use Brandenburg's conductive dome design in Macor, because this is a well known and conventional way to actuating a key, and both Macor and Brandenburg are required to push to enter, and they are in the same field of endeavor.

4. Claims 2-3, 5, 8, 12, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macor in view of Ishida (US 4611102).

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Regarding claims 2-3, 5, 8, 12, 15-16, Macor shows a key which functions as both a search and executing key.

Macor differs from the claimed invention in that it does not show that a first set keys for the searching and a second set of key for executing.

However, Macor does achieve the functions of the searching and executing an selected item.

Further, from the various embodiments disclosed in the present application, the first embodiment shows a single key which carries out the searching and executing functions, the second embodiment shows more than one key to carry out the searching and executing functions. And there is no teaching of criticality for one embodiment over the other. Further, Ishida teaches providing keys which also function as a joystick type of key. Hence, the concept of providing the searching and executing functions is well taught by Macor, therefore, it would have been obvious for one skilled in the art to modify Macor's joystick-type key with keys to carry the searching and executing functions with/without the teaching of Ishida. This simply can be considered as a variation of Macor as long as the basic searching and executing functions is substantially unchanged.



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**ARGUMENT**

5. In response to the remarks, in pages 5-11, Grisham and the JP reference are now withdrawn. No further discussion is made in regard to the above references. Macor and its combination are used to address the present claimed limitations, see rejection above.

6. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Chiang whose telephone number is (703) 305-4728. The examiner can normally be reached on Mon.-Fri. from 9:30 to 6:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Admad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

J. Chiang

January 9, 2001

  
JACK CHIANG  
PRIMARY EXAMINER